

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Olivier J. Poncelet, et al

INKJET RECORDING ELEMENT

Serial No. 10/522,006
Filed 14 July 2003

Group Art Unit: 1794

Examiner: David J. Joy

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

APPELLANTS' REPLY BRIEF

This Reply Brief is necessitated by several "new points of argument" in the Examiner's Answer mailed November 12, 2009.

In the "Response to Arguments" section (10) of the Examiner's Answer, the Examiner argues that while the present claims are drawn to an article/product ("an ink jet recording element") that comprises a support and at least one ink-receiving layer, where the ink-receiving layer comprises at least one hydrosoluble binder (e.g., gelatin or polyvinyl alcohol) and at least one aluminosilicate polymer that is obtained by the specified preparation method, Liu teaches an ink jet recording element that comprises a support and an ink-receiving layer, and the ink-receiving layer contains a polyvinyl alcohol binder and an aluminosilicate polymer, and that therefore it can be reasonably concluded that the teachings of Liu teach a product that "matches" that which is presently claimed, though the claimed invention is obtained by a process that is different from that which is taught in the references. Such argument by the Examiner continues to improperly ignore the evidence provided by Appellants in the specification that the specified relatively low ambient (i.e., 15-35°C)

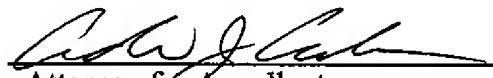
temperature preparation method is clearly taught as resulting in a unique aluminosilicate composition in comparison to aluminosilicate polymers of similar Al/Si ratios which are prepared by different processes involving heating above such claimed temperature, as evidenced by the Raman spectrum (see Figures 2 and 3) of aluminosilicate polymers of Examples 2 and 3 prepared in accordance with the invention, in comparison to the Raman spectrum (Figure 1) of a comparison aluminosilicate polymer prepared in a process employing heating substantially above ambient. These examples are consistent with Applicant's explanation that those skilled in the field of aluminosilicate chemistry understand that the nature of the resulting aluminosilicate product is extremely dependent upon the method of production. Comparative Example 5 and Inventive Example 7 further demonstrate that the unique aluminosilicates obtained by the specified process demonstrate unique properties in an ink jet recording element in accordance with the present invention relative to the use of other aluminosilicates. The Examiner's reluctance to consider all of the evidence leads to the clear error of the asserted rejection, as Liu et al. simply does not teach use of an aluminosilicate polymer that is necessarily identical to one obtained by the specified process, and thus does not anticipate the present claimed invention.

In the paragraph bridging pages 6-8 of the Answer, the Examiner apparently argues that while Appellant has demonstrated through the Examples of the present application that the present invention does exhibit improved performance with respect to such properties as dye keeping and gloss for ink jet recording elements, the Examiner has also stated that the teachings of Liu also recite that the inclusion of aluminosilicate in the ink-receiving layer results in an ink jet recording material that has high gloss, produces high quality images, and has a good dye keeping time, and Appellants have not provided a comparative evidentiary showing that patentably distinguishes the claimed invention from the prior art of record. In such regard, it is noted that the results presented in Liu are in not in comparison to any other aluminosilicate, but rather only in comparison to silica or alumina comparative examples. The actual comparisons presented in the present invention, on the other hand, include comparison in

performance to aluminosilicates made by other than the presently claimed requirements (but still made in a manner actually closer to the claimed requirements than the method employed in Liu) as well as to silica, alumina, and boehmite particles, are thus are clear evidence of the unique claimed materials relative to the prior art. While the Examiner argues that it remains unclear as to why the aluminosilicate polymer that is taught in the prior art is "not encompassed" by the polymer that is presently claimed, such unclarity on the part of the Examiner is only because the Examiner continues to refuse to consider the actual product-by-process limitations of the present invention, in combination with the actual evidence presented by Appellants that aluminosilicates prepared by different process result in different compositions with different performance characteristics. It is respectfully urged that in view of the actual claim requirements and demonstrated performance distinctions, the distinctions between the claimed invention and the cited prior art would be readily clear to one of ordinary skill in the art. In view of such actual evidence that processes even closer to that required for the claimed product-by-process materials result in identifiably different products, the asserted rejection represents clear error as the Examiner continues to fail to offer any reasonable technical basis for the speculative position, or otherwise explain why it would be reasonable to believe, that the aluminosilicate polymers prepared in Liu would be necessarily identical to the required claimed product-by-process materials.

For these reasons, as well as those presented in Appellants' Brief, Appellants respectfully submit that the Final Rejection is in error, and they request its reversal by the Honorable Board.

Respectfully submitted,


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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.